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In re the Application of

Group Art Unit: 3772

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Examiner: Brandon Lee Jackson

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FOR: Cheek Path Airway and Cheek Pouch Anchor

APPELLANT'S OPENING BRIEF

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1 APPELLANT'S OPENING BRIEF

2 (i) REAL PARTY IN INTEREST. The sole real party in interest is Applicant Lowell R.  
3 Wedemeyer.

4 (ii) RELATED APPEALS AND INTERFERENCES. There are no related appeals or  
5 interferences.

6 (iii) STATUS OF CLAIMS.

7 Claims 1 through 43 have been stated in the application.

8 Claims 1 - 32 have been withdrawn from consideration pursuant to the election  
9 required in the First Office Action.

10 Claims 33 - 43 remain pending in this application.

11 Claims 33 - 43 have been finally rejected in the Office Action mailed May 13, 2008.  
12

13 (iv) STATUS OF AMENDMENTS.

14 Applicant filed original claims 1 - 38.

15 Applicant filed preliminary amendments on April 22, 2004, which have been entered.

16 Pursuant to the election requirement imposed by the Examiner, Applicant elected  
17 claims 33 - 38 and withdrew from consideration claims 1 - 32.

18 Applicant added new claims 39 and 40 and a substitute specification by amendment  
19 filed May 18, 2007. They have been entered.

20 Applicant filed new claims 41 - 43 by amendment together with a request for further  
21 examination on September 12, 2007. They have been entered.

22 Claims 33 - 43 remain pending in this application.  
23

24 (v) SUMMARY OF CLAIMED MATTER.  
25

26 The Cheek Pouch Anchor. The "cheek pouch anchor" is claimed in independent claims 33  
27 and 41. The cheek pouch anchor is a spring element formed of a resilient filament coiled  
28 into a plurality of loops. See Figures 1 and 2, elements 28, 28a, 28b, 28c, 28d, 29 and 29a.

29 The plurality of loops enables the resilient filament to expand and contract within a  
30 user's cheek pouch so that the anchor dynamically maintains a span across the gap between  
31 a user's upper and lower teeth as the user's jaws open and close. See figure 3. Similarly,  
32 the anchor can maintain a span across the gap between a user's lips as the lips open and  
33 close. See figure 3.

1           Consequently, the cheek pouch anchor maintains its position within the cheek pouch,  
2           resists slipping between biting surfaces of the user's teeth, slipping out of the user's mouth  
3           between the user's lips, or slipping into the user's throat. The anchor fits within a one of a  
4           user's two cheek pouches. It has the structural strength to maintain itself within that cheek  
5           pouch with a work piece attached while the user's jaws and lips are free to open and close  
6           and without interfering with the user's tongue. See Figures 2, 3; specification para. [0031];  
7           claims 33, 34, and 41.

8           The cheek pouch anchor actually is part of the solution to larger problems concerning  
9           the stabilization of "cheek-side" airways that are intended to dwell within a user's mouth.  
10          The devices of Nelson (U.S. Patents 4,170,230, 4,261,354, 4,262,666, and 4,289,172), that  
11          Applicant believes are most closely related prior art, are stabilized cheek-side airways which  
12          have these problems. See specification paragraphs [0018] - [0020], [0054] and [0058] -  
13          [0064]. [Note 1] The anchor solution unexpectedly turned out to have additional  
14          capabilities and applications. See claims 36 - 40, 42 and 43.

15          Applicant's cheek pouch anchor, both separately and in combination with other  
16          elements, is summarized in the specification at paragraphs [0030] - [0034], [0049], and  
17          [0050]. The numbered elements of the cheek pouch anchor are listed in specification  
18          paragraphs [0140] - [0147]. The anchor is illustrated in figures 1, 2, 3, and 5. Detailed  
19          descriptions of the figures are at specification paragraphs [0192] - [0194] and [0196].  
20          Relevant anatomical definitions used in the claims are at specification paragraphs [0036] -  
21          [0044]. Definitions of some words used in the claims appear at specification paragraphs  
22          [0222] - [0228].

23          The term "user's cheek pouch" is defined in paragraph [0041] of the specification as  
24          follows:

25                "User's cheek pouch" lies between the inner wall of one of such user's two cheeks and  
26                the cheek-adjacent side of such user's dental arches, gums and teeth. A user's cheek  
27                pouch extends along such user's anterior-posterior ("vertical") body axis between the  
28                junctures of such user's mandibular and maxillary dental arches with such user's inner  
29                cheek wall. Such cheek pouch extends along such user's dorsal-ventral body axis

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1   All references herein are to the substitute specification filed May 18, 2007,  
which includes the paragraph numbering inserted by the PTO for publication of the  
original application.

1 approximately from a user's front teeth to the general area of such user's most-dorsal  
2 teeth and rear-jaw gap. The configuration of a user's cheek pouch dynamically alters  
3 as the user's jaws and lips open and close. A user has two cheek pouches located on  
4 opposing sides of a user's mouth." [Note 2]

5 See the dotted outline of a user's cheek pouch which is element 50 in Figure 3, described at  
6 specification paragraph [0176].

7 Please note that the biting ("occlusal") surfaces of a user's teeth are beyond the limits  
8 of a "user's cheek pouch", and so are the occlusal surfaces of a user's lips. The cheek  
9 pouch anchor is designed to avoid the biting surfaces of a user's teeth as well as the user's  
10 tongue and lips. See Figure 3, element 50, defined in Applicant's specification, paragraph  
11 [0031], p. 9, lines 14 - 19.

12 The anchor is designed, depicted and claimed "to allow a user's jaws and lips to fully  
13 close while said spring element is within a user's cheek pouch." Figure 3; Claims 39 and 40,  
14 substitute specification page 34, lines 10 - 11 and page 35, lines 9 - 10; and Claims 41 and  
15 43 in the Request for Further Examination filed September 12, 2007, pages 17 - 18. When  
16 emplaced within a user's cheek pouch, as in figure 3, the cheek pouch anchor does not  
17 encumber the opening and closing of a user's lips. Thus, the emplaced anchor does not  
18 aggravate the lip-sealing problems of airways that are described in specification paragraphs  
19 [0065] - [0066]. See also the list of objectives and features in specification paragraphs  
20 [0070] - [0075].

21  
22 Adjustability of the Cheek Pouch Anchor. In claims 36 and 39 the size of the anchor as  
23 a whole can be adjusted for different sized mouths. It is an objective of the invention that  
24 lay persons be capable of inserting, adjusting, using and removing it by themselves, and  
25 adjusting it for a particular user's comfort. Specification paragraphs [0079] - [0080]. The  
26 mechanism of adjustability is explained by reference to figure 1 at specification paragraph  
27 [0192], page 21, lines 21 - 24. In claim 36 the whole anchor can be adjusted by mutually  
28 converse adjustments of two or more of the plurality of loops from which the whole anchor is  
29 formed. Claim 39 requires adjustment of the loop span of at least one of the plurality of

---

2 The phrases "user's cheek pouch" and "a user's cheek pouch" are explicitly  
defined in the singular, with an explicit notation that a user has two cheek pouches.  
This explicitly defined term then is used in the claims.

1 loops, relative to the loop span of at least one other loop, to translate into adjustment of the  
2 span size of the whole spring element.

3  
4 The Cheek Pouch Anchor Combined With Additional Elements. Applicant also claims a  
5 combination of the cheek pouch anchor with two distinct types of additional elements.

6 Claims 35 and 42 combine the elements of the cheek pouch anchor with a conduit  
7 for a fluid that Applicant calls a "cheek path airway." See Figure 2, elements 1 - 6. The  
8 cheek path airway is shaped to carry air or other fluids in either direction along a "cheek  
9 path." The "cheek path" traverses between a user's lips, through a user's cheek pouch,  
10 curves through a user's "rear-jaw gap" behind a user's rear-most teeth, and reaches into the  
11 airspace above a user's tongue at the rear of a user's mouth. See Figure 3. The cheek  
12 path airway attaches to the cheek pouch anchor and is stabilized within a user's mouth by  
13 the anchor while the user's jaws remain free to open and close.

14 Claims 38, 40 and 43 combine the elements of the cheek pouch anchor with a  
15 capacity to carry a substance and release that substance within a user's mouth.

16  
17 (vi) GROUND OF REJECTION TO BE REVIEWED ON APPEAL.

18 Applicant appeals from all grounds of rejection. They are as follows:

19 Claims 33-36 and 39 - 42 are rejected under 35 U.S.C. 102(b) as being anticipated by  
20 Leal (U.S. Patent 5,199,872).

21 Claims 37-38 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
22 Leal (U.S. Patent 5,199,872) in view of Diaz (U.S. Patent 4,041,937).

23  
24 (vii) ARGUMENT.

25 Summary of Argument.

26 Applicant amended to add new claims 41 - 43 in order to focus certain issues for  
27 appeal. Applicant's argument initially focuses upon claims 41 - 43 for simplicity. Similar  
28 though not precisely identical issues arise in each of claims 33 - 40.

29 This appeal shows that the Examiner repeatedly has factually misstated the function  
30 and structure of the cited prior art Leal. The Examiner imputes characteristics that are  
31 incompatible with Leal's intended function and that might occur, if at all, only in a  
32 malfunctioning Leal device. The Examiner imputes to Leal's device characteristics that it  
33 simply does not have. The Examiner improperly imputes characteristics to Leal through

1 speculative hypotheses that lack proper factual foundation in either cited prior art or the  
2 application. The Examiner repeatedly substitutes his own idiosyncratic definitions in place  
3 of, and inconsistently with, the explicit definitions in Applicant's specification.

4 Summary Re Anticipation Under 35 U.S.C. 102(b).

5 ISSUE 1 Summary. In claims 41 - 43 Applicant's structural limitation "sized to fit **within**  
6 **one of** a user's cheek pouches" is a closed-ended limitation that structurally distinguishes  
7 Applicant's claimed "cheek pouch anchor" from the device of Leal (U.S. Patent 5,199,872).  
8 Applicant uses the word "within," in its plain, standard, dictionary meaning "inside the limits  
9 of; not beyond." Applicant's specification, paragraph [0041] specially defines the limits of a  
10 "user's cheek pouch." Applicant expressly declared this phrase to be closed-ended when  
11 amending to add claims 41 - 43. (Request for Further Examination, filed September 12,  
12 2007, pp. 2-3). This claim limitation negates anticipation by Leal's structure. The Examiner  
13 improperly refuses to accord any weight to Applicant's claim limitation "sized to fit **within one**  
14 of a user's cheek pouches."

15 Leal's structure cannot fit **within one** of a user's two cheek pouches, and also cannot  
16 fit **within two** of a user's cheek pouches, but can only fit **into** two cheek pouches while  
17 simultaneously extending beyond two cheek pouches. Leal's u-shaped upper and lower  
18 sections (12, 14) and flexible connections (24) necessarily must simultaneously fit **into** both  
19 of a dental patient's's cheek two pouches, between the patient's lips and gums around the  
20 outside of the patient's dental arches. (Leal's Figures 1, 2, 4 and 5, and specification, col.  
21 1, line 50 - col. 2, line 17; col. 2, line 58 - col. 3, line 1; col. 3, line 50 - col. 4, line 13). Leal's  
22 forwardly projecting tabs (32, 24) project out between a patient's lips so those tabs can be  
23 grasped, compressed, and released by the dentist's fingers (col. 4, l. 25 - 35; col. 5, l. 15 -  
24 30). Thus Leal's tabs extend beyond the limits of both of a user's two cheek pouches, as  
25 those limits are defined in Applicant's specification paragraph [0041] and depicted by dotted  
26 line 50 in Applicant's figure 3. In addition, Leal's tongue depressor (26, 28, 30) extends  
27 across the patient's dental arches over the patient's tongue, beyond the limits of two of the  
28 "user's cheek pouches" as those limits are defined in Applicant's specification, paragraph  
29 [0041].

30 The Examiner incorrectly construes the word "within" to mean "simultaneously inside  
31 and outside," which is repugnant to the plain, standard meaning of "within." Final Office  
32 Action, May 13, 2008, p. 2. The Examiner then incorrectly construes Applicant's closed-  
33 ended phrase "within one of" a user's cheek pockets" to mean that the claimed anchor

1 simultaneously occupies both of a user's two cheek pockets, in direct contradiction of the  
2 plain meaning of Applicant's claim language. *Id.*

3 If there are any material structural differences between a claim and the prior art, that  
4 prior art does not anticipate. None of Applicant's claims 33 - 43 includes any structure  
5 equivalent to Leal's tabs (32, 34) or to Leal's tongue depressor (26, 28, 30). The phrase  
6 "within one cheek pouch" in claims 41 - 43 therefore does not read on Leal and negates  
7 anticipation by Leal.

8  
9 ISSUE 1.1 Summary. Applicant's claims 33 and 38 use the syntax, " ... comprising: A  
10 spring element adapted to be placed ***within a user's cheek pouch ....***". The phrase "a  
11 user's cheek pouch" in normal patent parlance has the open-ended meaning "one or more  
12 cheek pouches." The word "within" still has the closed-ended meaning "inside the limits of;  
13 not beyond." By special definition in specification paragraph [0041] a user has two cheek  
14 pouches. Thus, the phrase "within a user's cheek pouch" following the transition word  
15 "comprising" has the partially open meaning "inside and not beyond the limits of one or two  
16 cheek pouches."

17 Applicant's claims 39 and 40 also use similarly partially-open syntax, "sized to fit ***within***  
18 ***a*** user's cheek pouch."

19 When Applicant's claim phrase "***a*** user's cheek pouch" is read as the partially open  
20 phrase "one or two cheek pouches," the claim still does not read on Leal because Leal does  
21 not possess that structural limitation. Leal's device cannot fit ***within two*** cheek pouches, but  
22 can only fit ***into*** two cheek pouches while also necessarily extending beyond them.

23 The phrase "within ***a*** user's cheek pouch" in claims 33 - 40 does not read on Leal's  
24 structure.

25  
26 ISSUE 2 Summary. In claims 41 - 43, Leal's device also is structurally distinguished from  
27 Leal by Applicant's claim limitation:

28 "A spring element ... having a dynamic span such that ....

29 ***said spring element flexibly compresses to allow a user's jaws and lips to fully***  
30 ***close while said spring element is within one or more of a user's cheek***  
31 ***pouches...***

32 Applicant's anchor is claimed to fit and to compress within a user's cheek pouch. When  
33 within the user's cheek pouch, as claimed, Appellant's anchor is compressed by the soft

1 tissues of the user's cheek pouch. The limits of a user's cheek pouch as defined in  
2 specification paragraph [0041] do not include the biting surfaces of the user's teeth, nor the  
3 occlusal surfaces of a user's lips.

4 The claimed compressibility of Applicant's anchor allows the user to fully close jaws  
5 and lips while the anchor is within the user's cheek pocket. This structurally distinguishes the  
6 claimed anchor from Leal's device. Leal repeatedly states that his device prevents a dental  
7 patient's mouth from closing. Leal's tabs (32, 34) project out between a patient's lips for the  
8 dentist to grasp with fingers to compress. That is, Leal's device is a dental retractor. It is  
9 intended to be compressed by a dentist's fingers using tabs (32, 34) for insertion into a  
10 patient's mouth, whereupon the dentist releases tabs (32, 34) allowing resilient, flexible  
11 connections (24) to expand Leal's upper and lower sections (12, 14) and thereby "prevent" a  
12 patient's mouth from closing during dental procedures. (Leal, col. 2, l. 58 - col. 3, l. 17; col.  
13 5, l. 15 - 30; figures 1, 2, and 4; claims 1, 10 - 12.)

14 The Examiner speculates, without any evidence, that a dental patient could close the  
15 patient's mouth by using teeth or lips to compress Leal's tabs (32, 34). The Examiner's  
16 speculations concerning compression of Leal's tabs (32, 34) by lips or teeth directly  
17 contradict Leal's many express statements in both his specification and claims that his device  
18 maintains a dental patient's mouth open and "prevents" it from closing. It is not possible for  
19 a patient to bring teeth to bear on Leal's tabs (32, 34) when the device is inserted into the  
20 patient's mouth as Leal says he intends. Lips are not as strong as fingers so there is no  
21 inference that a patient's lips could compress tabs (32, 34) merely because a dentist's fingers  
22 could.

23 Even if the Examiner's speculation were true (which the Examiner has not proven),  
24 Applicant's anchor, as claimed, has no equivalent of Leal's tabs (32, 34). Therefore,  
25 Applicant's claims do not read on the Examiner's speculative construction of Leal.

26 The biting surfaces of a user's teeth and the occlusal surfaces of a user's lips are  
27 beyond the limits of a "user's cheek pouch" as defined in Applicant's specification and used in  
28 the claims. Applicant expressly claims that his anchor is compressible "while said spring  
29 element is within" the user's cheek pocket, in which position the occlusal surfaces of the  
30 user's lips and teeth cannot come to bear to compress Applicant's claimed anchor.

31 Leal does not anticipate Applicant's claim that Applicant's anchor is compressible to  
32 allow the user's jaws and lips to fully close while the anchor is within a user's cheek pouch.  
33



1 ISSUE 3 Summary. Applicant's claim limitation "a conduit for a fluid" does not read on  
2 Leal's cotton rolls that cushion Leal's appliance (10) and absorb saliva. Leal, col. 4, l. 51 -  
3 55. Applicant's specification paragraph [0224] explicitly defines the word "conduit" for use in  
4 the claims as follows: "Conduit" means a hollow tube or channel capable of conveying fluids  
5 along its longitudinal axis, which axis may be curved [with additional elaboration]."  
6 Applicant's explicit definition is consistent with definitions in several, different dictionaries.  
7 Leal's cotton roll is not a "conduit" according to Applicant's explicit definition in the  
8 specification, nor is it a conduit according to the plain meaning of "conduit" in dictionaries.

9 The Examiner explicitly violated the rule of law that an applicant is entitled to be his  
10 own lexicographer. The Examiner rejected claims 35 and 42 by improperly substituting the  
11 Examiner's own, unreasonably broad, idiosyncratic definition as follows:

12 "Examiner has given the term conduit its broadest, most reasonable definition, which is  
13 an element with a hole therethrough that can transfer air or fluid, which is the cotton  
14 surround the spring element (40)."

15 The Examiner's excessively broad definition eliminates the semantic distinction between  
16 "hole" and "conduit." It is not consistent either with the plain meaning of dictionary definitions  
17 of "conduit" or with Applicant's explicit definition in the specification.

18  
19 ISSUE 4 Summary. In claims 33 - 38, the Examiner incorrectly refused to consider  
20 Applicant's claim phrase "adapted to ...." and all limiting language following that phrase. The  
21 Examiner states:

22 "The "adapted to ..." language has not been considered since it has been held that the  
23 recitation that an element is "adapted to" perform a function is not a positive limitation,  
24 but only requires the ability to so perform. It does not constitute a limitation in any  
25 patentable sense. *In re Hutchinson*, 69 USPQ 138." Final Office Action mailed May  
26 13, 2008, pp. 4-5, and p. 6.

27 There is no such legal principle. In *MPEP* § 2173.05(g) the USPTO has adopted the modern  
28 view that the phrase "adapted to ..." can be employed following the word "comprising" to  
29 state a valid functional limitation. The Examiner materially misstates the current state of the  
30 law in general and misstates *In re Hutchinson* in particular. *In re Hutchinson* disregarded the  
31 phrase "adapted for ..." because the phrase was in a preamble before the transitional word  
32 "comprising," not in the body of the claim. Applicant uses the phrase in the body of claims,  
33 after the word "comprising."

1 ISSUE 5 Summary. Leal's device does not anticipate the particular kind of structural  
2 adjustability of the cheek pouch anchor that is stated in claims 36 and 39. The Examiner's  
3 argument for rejection is that "it would be obvious to one of ordinary skill in the art to bend the  
4 wires of the Leal device in order to better fit the user." Final Office Action mailed May 13,  
5 2008, p. 3. That is, the rejection is on the formal ground of anticipation, but the Examiner's  
6 supporting rationale is obviousness. The Examiner confuses inherency for purposes of  
7 anticipation with obviousness. The Examiner fails to apply the proper test for inherency, fails  
8 to make out inherency, and fails to show anticipation.

9 The Examiner also fails to show prima facie obviousness. The Examiner states a  
10 premise that it would be obvious for one of ordinary skill to adjust Leal's device by bending it.  
11 But the Examiner then improperly leaps to the unfounded, incorrect conclusion that it would  
12 be obvious to bend Leal's wires *according to the particular structural mechanism that*  
13 *Applicant claims* for achieving adjustability in the cheek pouch anchor. The Examiner's  
14 obviousness argument does not meet the strict test of inherency for the purpose of  
15 anticipation. See *MPEP 2112, subd. IV*. Where a characteristic must be achieved by  
16 optimization of a prior art device, that characteristic is not necessarily present in the prior art  
17 and therefore is not inherent. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955; *In re*  
18 *Oelrich*, 666 F.2d 578, 581-582, 212 USPQ 323, 326 (CCPA 1981).

19 The Examiner inconsistently presumes both that Leal's wire possesses sufficient  
20 ductility to enable bending of Leal's upper and lower sections (12, 14) to adjust Leal's wire to  
21 patient deformities, and that the wire also simultaneously has resilience to return to its  
22 original shape when deformed. Final Office Action, May 13, 2008, pp. 2 - 4. Resilience  
23 counters ductility (or malleability). The resilient-versus-ductile properties of Leal's wire would  
24 have to be optimized to achieve a special balance between resilience and ductility, if such a  
25 balance could be achieved at all. Leal specifies resilience but does not disclose any such  
26 special balance between resilience and ductility. Such a balance is not an inherent feature  
27 of Leal's device, so a capacity to accept ductile bending is not inherent. The Examiner  
28 deconstructs Leal's device, element by element, and then contorts individual elements, but  
29 fails to consider how Leal's device as a whole would malfunction when re-constructed of the  
30 Examiner's contorted elements.

31 The Examiner not only fails to show inherency, but also fails to show prima facie  
32 obviousness. It would not be obvious to adjust the whole span of Leal's device according to  
33 the teaching of Applicant's claims. Assuming (without conceding) that Leal's device

1 necessarily would sustain ductile bending, a person of ordinary skill in the art seeking to alter  
2 the whole span of Leal's device would be motivated to ductilely bend Leal's device in the  
3 most simple, obvious place, at flexible connections (24), to achieve a simple, predictable  
4 result. Such a person of ordinary skill would be motivated to avoid using complex, ductile  
5 bending of Leal's u-shaped upper and lower sections (12, 14) to adjust the whole span of  
6 Leal's device. This is because such complex, ductile bending predictably would cause a  
7 cascade of adverse changes in other parts of Leal's device which would strongly tend to  
8 impair the intended function of Leal's device. If the whole span of Leal's device (10) were to  
9 be altered in the course of bending Leal's upper and lower sections (12, 14) to accommodate  
10 a patient's over-bite or other deformity, then that would only be accidental. There would be a  
11 strong motivation to bend Leal's sections (12, 14) in such a way as to avoid altering the whole  
12 span. The Examiner concedes that such bending of Leal's sections (12, 14) "may not be the  
13 easiest and most effective way" to adjust the whole span of Leal's device. Final Office Action  
14 mailed May 13, 2008, p. 4. That shows non-obviousness, not prima facie obviousness.

15  
16 ISSUE 6 Summary. Claims must be construed as a whole, giving weight to each and all  
17 limitations. When each of Applicant's claims 33 - 36 and 39 - 42 is viewed as a whole Leal  
18 does not anticipate any of those claims as a whole. The Examiner has contorted Leal on an  
19 element- by-element basis, but when one attempts to view as a whole the Examiner's various  
20 contortions of Leal's device it is rendered unrecognizable and unfit for its intended purpose.  
21 The Examiner then improperly substitutes his own unreasonable definitions for the definitions  
22 in Applicant's specification in order to read Applicant's claims on the Examiner's contorted  
23 constructions of Leal.

24 Complexity is not a requirement for patentability. It is incorrect to hold that an invention  
25 was obvious when made, simply because the invention is simple in nature and is easily  
26 understood when described in a patent specification. Some of the simplest advances have  
27 been the most nonobvious. When the art in question is relatively simple, as Appellant's  
28 solution is here, the opportunity to judge by hindsight is particularly tempting so particular  
29 awareness of that risk is important here. It still is the law under the U.S. Supreme Court's  
30 recent decision that an examiner must guard against slipping into the use of hindsight and  
31 must guard against the temptation to read into prior art the teachings of the invention in  
32 issue. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed. 2d 705, 82  
33 *USPQ2d(BNA) 1385 (U.S. Sup. Ct., 2007).*

1                   Summary Re Rejections Under 35 U.S.C. § 103 For Obviousness.

2  
3       ISSUE 7 Summary.    Claims 37, 38 and 43, to a cheek pouch anchor combined with a  
4       capacity to carry and release a substance in a user's mouth, are not rendered obvious by  
5       Leal (U.S. Patent 5,199,872) in view of Diaz (U.S. Patent 4,041,937). The Examiner's  
6       rationale is that Leal anticipates all elements of Applicant's cheek pouch anchor stated in  
7       claims 37, 38 and 43, but that Leal lacks the added element which comprises a capacity to  
8       carry and release a substance in the user's mouth. The Examiner combines Diaz (U.S.  
9       Patent 4,041,937) with Leal only to demonstrate that additional substance-carrying-and-  
10      release capacity in prior art. The Examiner is in error that Leal anticipates the elements of  
11      the cheek pouch anchor stated in claims 37, 38 and 43, for all the reasons stated with  
12      respect to Issues 1 - 4 and 6 above. Because Leal does not anticipate the claimed elements  
13      of the cheek pouch anchor, and Diaz does not cure this lack in Leal, therefore the  
14      combination of Leal with Diaz does not render claims 37, 38 and 43 obvious.

15  
16                   ARGUMENT RE REJECTIONS UNDER 35 U.S.C. § 102(b) FOR ANTICIPATION

17  
18       ***ISSUE 1.*** In claims 41 - 43, does Applicant's limitation "sized to fit ***within one of*** a user's  
19      cheek pouches" read on Leal (U.S. Patent 5,199,872)? (bold, italic emphasis added).

20  
21                   Argument On Issue 1.

22                   Anticipation Under 35 U.S.C. 102(b). A claim is anticipated only if each and every  
23      element as set forth in the claim is found, either expressly or inherently described, in a single  
24      prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2  
25      USPQ2d 1051, 1053 (Fed. Cir. 1987).

26                   The Examiner's Argument Contradicts the Plain Meaning of "Within"; Leal's Device  
27                   Cannot Fit "Within" Either One or Two Cheek Pouches.

28                   The word "within" means "in the compass of; not beyond", or "in the limits of, not going  
29      beyond". *Random House Webster's Dictionary*, 1993, Random House, Inc.; *Chambers's*  
30      *Twentieth Century Dictionary*, 1965, W.&R. Chambers, Ltd., first American edition. "Within"  
31      does not mean "simultaneously inside and outside the limits of." "Within" does not mean  
32      "into".

33                   Applicant's structural limitation "sized to fit ***within one of*** a user's cheek pouches" is a

1 closed-ended limitation that distinguishes Applicant's claimed "cheek pouch anchor" from the  
2 device of Leal (U.S. Patent 5,199,872). It negates anticipation. This is because Leal's "u-  
3 shaped" structure necessarily must simultaneously fit into both of a patient's two cheek two  
4 pouches, and Leal's tabs (32, 24) project between a patient's lips, and Leal's tongue  
5 depressor crosses a patient's dental arches over a patient's tongue. (Leal's Figures 1, 2, 4  
6 and 5, and specification, col. 1, line 50 - col. 2, line 17; col. 2, line 58 - col. 3, line 1; col. 3,  
7 line 50 - col. 4, line 13.) Leal's structure is incapable of fitting within one of a user's two  
8 cheek pouches. As explained in detail in Appendix 1, Leal's tabs (32, 24) are an essential,  
9 integral element of structure that enables compression of Leal's device by a dentist's fingers  
10 for insertion into and removal from a patient's mouth; Leal states that when his device is in  
11 the patient's mouth it maintains the mouth open and prevents the mouth from closing

12 Applicant's Response filed May 18, 2007, pp. 3 - 4, pointed out that Applicant specially  
13 defines the anatomical term "user's cheek pouch" in Applicant's specification, paragraph  
14 [0041] and illustrates it with the dotted line 50 in Figure 3, as described in specification  
15 paragraph [0176]. It also pointed out that the term "user's cheek pouch" is defined in the  
16 singular. The Examiner's next Office Action again rejected, stating incorrectly,

17 "claiming the device fits in one cheek pouch does not limit it to not be able to fit in the  
18 other cheek pouch, because there is no negative limitation preventing it from being  
19 within both cheek pouches. Office Action mailed November 9, 2007.

20 Applicant filed new claims 41 - 43 in order to focus this precise issue in claims that  
21 unequivocally negate the Examiner's assertion. Applicant explicitly declared that the newly-  
22 stated structural limitation "sized to fit within one of a user's cheek pouches" is semantically  
23 closed-ended. Request for Further Examination, filed September 12, 2007, p. 3.

24 Applicant declines to disclaim the plural interpretation of "a user's cheek pouch" in  
25 claims 33 - 40, but rather Applicant has filed new, more narrow claims 41 - 43 while still  
26 insisting that broader claims 33 - 38 also are adequately distinguish Leal's structure.  
27 Compare *KCJ Corporation v. Kinetic Concepts, Inc.*, 223 F. 3d 1351, 1356, 55 USPQ2d  
28 (BNA) 1835 (Fed. Cir. 2000) (indefinite article "a" following open-ended word "comprising"  
29 means "one or more"; but applicant may disclaim before the PTO a plural interpretation of  
30 indefinite article "a").

31 The Examiner's final Office Action then improperly rejected Applicant's new closed-  
32 ended limitation in claims 41 - 43, stating:

33 "Applicant argues the Examiner has improperly disregarded a closed limitation of sized

1 to fit within one of a user's cheek pouches. Applicant has not claimed **only one cheek**  
2 **pouch**; a device can be sized to fit within one cheek pouch while simultaneously fitting  
3 into another cheek pouch." Final Office Action mailed May 13, 2008, p. 2. (emphasis  
4 added).

5 Both of the Examiner's two statements are incorrect.

6 In the Examiner's first statement ("Applicant has not claimed only one cheek pouch"),  
7 the Examiner's adds the redundant word "only" to the already-closed phrase "**within one** of a  
8 user's cheek pouches." "Only" adds nothing to the already-closed limitation.

9 The Examiner's construction "fit within one ... while simultaneously fitting into another  
10 ...", is repugnant to the plain meaning of the word "within."

11 Leal's device cannot even fit **within two** cheek pouches, but can only fit **into** two cheek  
12 pouches while also extending beyond them. This is because Leal's tabs (32, 24) project out  
13 between a patient's lips so they can be grasped by the dentist's fingers. Tabs (32, 34) extend  
14 outside the limits of **two** "user's cheek pouches" as those limits are defined in Applicant's  
15 specification. In addition, Leal's tongue depressor (26, 28, 30) extends across the patient's  
16 dental arches over the patient's tongue, beyond the extents of two user's cheek pouches.

17 The Examiner's second statement ("a device can be sized to fit within one cheek pouch  
18 while simultaneously fitting into another cheek pouch") is ambiguous. It has two possible  
19 meanings. Both possible meanings are incorrect.

20 Meaning 1. A single macroscopic device cannot **simultaneously** display two different  
21 physical sizes, a smaller size limited to fit within one of a user's cheek pouches, and a larger  
22 size that exceeds the size of one of a user's cheek pouches and thus spills over into the  
23 second cheek pouch. When read in this sense, the Examiner's second statement is internally  
24 contradictory.

25 Meaning 2. The claimed anchor could be placed between the user's lips and front  
26 teeth, where it would lie across the boundary between the user's two cheek pouches and  
27 thus "simultaneously" lie partially in one cheek pouch and partially in the other cheek pouch.  
28 However, the particular location of **placement** of the anchor in a user's mouth does not alter  
29 the **structural limit** on the anchor's inherent compressibility. The claims do not read on Leal  
30 even if the one-pouch-sized anchor were to be **placed** so that the anchor lies partly within  
31 one cheek pouch and partly within the other cheek pouch. No matter where placed, the  
32 structure of the anchor, as claimed, still has the inherent capacity to fit within the size of one  
33 cheek pouch, whereas Leal's device never can be so compressed to fit within one cheek

1 pouch. If read in this second sense, the Examiner's statement (that Applicant's anchor can  
2 simultaneously fit into two cheek pouches) again fails to demonstrate anticipation by Leal's  
3 device. Rather, it shows an improper focus by the Examiner upon one aspect of the  
4 performance of the claimed anchor rather than upon plain, claimed, structural differences.  
5 *MPEP § 2114; Hewlett-Packard v. Bausch & Lomb, 909 F. 2d 1646, 1468; 15 U.S.P.Q.2d*  
6 *(BNA) 1525.*

7 The Wide Range of Expansion of the Claimed Anchor Structurally Distinguishes the  
8 Claimed Anchor from Leal's Device.

9 The size of Applicant's anchor is limited in claims 41 - 43 so that the anchor is capable  
10 of compression enabling the claimed anchor to fit **within** one of a user's cheek pouches,  
11 whether the user's jaws and lips are open or closed. This claimed inherent structural  
12 compressibility of the cheek pouch anchor does not read upon Leal. This is because Leal's  
13 u-shaped upper and lower sections (12, 14) and resilient connections (24) necessarily must  
14 simultaneously fit *into* both of a user's cheek pouches and never can be compressed to fit  
15 *within* one cheek pouch.

16 The claimed compressibility of Applicant's anchor is an inherent structural difference  
17 from Leal's device that negates anticipation by Leal. See *MPEP § 2114*.

18 Apparatus claims cover what a device is, not what the device does. An invention need  
19 not operate differently than prior art to be patentable, it need only be structurally different.  
20 *Hewlett-Packard Co. v. Bausch & Lomb Incorporated, 909 F.2d 1464, 1468, 15 USPQ2d*  
21 *(BNA) 1525 (Fed. Cir. 1990).*

22 The claimed cheek pouch anchor also is capable of adjustment that would enable it to  
23 expand from a one-pouch size to reach into a second pouch so the anchor could be within  
24 the two cheek pouches, not just within one cheek pouch. This is another claimed, structural  
25 feature that Leal's device does not possess. The structural mechanism of adjustability is  
26 claimed in claims 36 and 39.

27 If the Examiner's second statement ("a device can be sized to fit within one cheek  
28 pouch while simultaneously fitting into another cheek pouch") is read in this sense, it still  
29 does not demonstrate anticipation by Leal's device. Instead it shows that the cheek pouch  
30 anchor inherently can be adjusted do two things that Leal's structure cannot do, either fit  
31 within one cheek pouch or fit within two cheek pouches. The Examiner again is incorrectly  
32 focusing upon one aspect of the performance of the claimed anchor rather than upon plainly  
33 claimed structural differences. *MPEP § 2114; Hewlett-Packard v. Bausch & Lomb, supra.*

1           **Sub-Issue 1.1** In claims 39 - 40, does Applicant's claim limitation "sized to fit within **a**  
2 user's cheek pouch" read on Leal's device?

3  
4           **Argument on Sub-Issue 1.1.** Applicant's limitation in claims 39 - 40, "sized to fit  
5 within **a** user's cheek pouch" follows the open-ended transition word "comprising." In normal  
6 patent parlance the article "a" is read as open-ended to mean that the cheek pouch anchor  
7 must be sized to fit within "one or more cheek pouches". In this Application it would mean  
8 "one or two" cheek pouches because a user, by definition, has only two. Yet even when  
9 Applicant's claim limitation "sized to fit within **a** user's cheek pouch" is read as the open-  
10 ended "one or two cheek pouches" it still does not read on Leal because that is a structural  
11 limitation that Leal's device does not possess -- a capacity either to fit **within one** pouch or  
12 by adjustment to fit **within two** cheek pouches. As explained above, Leal's device can only  
13 fit **into**, but not **within**, two cheek pouches.

14           See also in claims 33 and 38, "A spring element adapted to be placed **within a user's**  
15 **cheek pouch ...**".

16           Would a device such as Leal's infringe upon Applicant's claims 33 and 38 - 40 when  
17 the claim phrase "a user's cheek pouch" is read to mean "one or two user's cheek pouches"?  
18 Plainly not, due to more than one structural difference.

19           Leal states that Leal's device is intended to be compressed by force imposed on Leal's  
20 tabs (32, 34), but Applicant's claimed anchor has no structural element equivalent to Leal's  
21 tabs. Recognizing this, the Examiner speculates that a patient could compress Leal's tabs  
22 (32, 34) using either teeth or lips. Assuming for the sake of argument, but without  
23 conceding, that the Examiner's speculation were true, Leal still would not be anticipating  
24 because Applicant's claims have no structure equivalent to Leal's tabs.

25           The Examiner's speculation that a patient could compress Leal's device with a patient's  
26 lips or teeth contradicts Leal's specification. Leal repeatedly states that his device prevents  
27 the closing of a patient's mouth and maintains the patient's mouth in an open condition, as  
28 showed in detail in Appendix 1. By distinction, Applicant's claimed anchor is explicitly limited  
29 in claims 39-40 to be "flexibly compressible to allow a user's jaws and lips to fully close while  
30 said spring element is within a user's cheek pouch ... ". This claimed compressibility of  
31 Applicant's anchor is distinctly, structurally different from Leal's device.

32           Both of these claimed **structural** differences exist regardless of whether Leal's tabs  
33 (32, 34) are compressed by a dentist's fingers, as Leal explicitly intends, or could be



1 compressed by a patient's teeth as the Examiner incorrectly speculates.

2 The differences in compressibility are discussed in more detail in Issue 2 below.

3  
4 **ISSUE 2.** In claims 41 - 43, does the following combination of limiting claim phrases  
5 read upon Leal's device: "A spring element

6 ***sized to fit within one of a user's cheek pouches***, and

7 having a dynamic span such that ... ***said spring element flexibly compresses to***

8 ***allow a user's jaws and lips to fully close while said spring element is within one***  
9 ***or more of a user's cheek pouches...***?"

10  
11 **Sub-ISSUE 2.1.** In claims 39 and 40, does the following combination of limiting claim  
12 phrases read upon Leal's device:

13 "a spring element formed of a resilient filament

14 ***sized to fit within a user's cheek pouch***, and

15 having a dynamic span

16 that is resiliently expandable within a user's cheek pouch to maintain a bridge  
17 across a user's inter occlusal space and lip opening that form as a user's jaws  
18 open, and

19 ***that is flexibly compressible to allow a user's jaws and lips to fully close***  
20 ***while said spring element is within a user's cheek pouch, ...***"

21  
22  
23 **Sub-ISSUE 2.2.** In claims 33 - 37, does the following combination of limiting claim  
24 phrases read upon Leal's device:

25 "A spring element adapted

26 - to be placed ***within a user's cheek pouch***, and

27 - ***to compress as a user's jaws close***, and

28 - to resiliently expand so as to form and maintain a span bridging across a user's inter  
29 occlusal space and a user's lip opening formed ***as a user's jaws and lips open and***  
30 ***close, ...***?"

31  
32 **Sub-ISSUE 2.3.** In claim 38, does the following combination of limiting claim phrases  
33 read upon Leal's device:

1 "A spring element adapted  
2 - ***to be placed within a user's cheek pouch***, and  
3 - ***to compress as a user's jaws close, ...***"  
4

5 **Argument on Issue 2 and Related Sub-Issues.**

6 In claims 41 - 43, Leal's device is structurally distinguished by Applicant's claim  
7 limitations "A spring element

8 ***sized to fit within one of a user's cheek pouches***, and  
9 having a dynamic span such that

10 ....

11 ***said spring element flexibly compresses to allow a user's jaws and lips to***  
12 ***fully close while said spring element is within one or more of a user's***  
13 ***cheek pouches...***"

14 The similar claim limitations in claims 33 - 40 also structurally distinguish Leal's device.

15 Issue 2 and its subparts concern the proper factual interpretation of Leal's device as  
16 actually disclosed by Leal's specification, figures and claims. The Examiner repeatedly has  
17 factually misstated the function of Leal's structure. The Examiner imputes to Leal's device  
18 characteristics that it simply does not have, and characteristics that are incompatible with  
19 Leal's intended function and would occur, if at all, only in a malfunctioning Leal device. The  
20 Examiner states:

21 "Applicant argues Leal's tabs (32, 34), would not contact the teeth of the user,  
22 however, the intended use is for the user's teeth not to contact the tabs; but it would be  
23 obvious that one's teeth could be able to contact the tabs, depending upon the size and  
24 placement of the device. Moreover, Leal's device could be compressed by the lips of  
25 the user or by the compression of the jaw when the user's closes his/her mouth." Final  
26 Office Action mailed May 13, 2008, p. 2.

27 Applicant traverses the Examiner's statements as factually unsupported speculations that  
28 contradict Leal's descriptions of his device and its functions.  
29

30 **The Examiner Ignores Significantly Limiting Language Of Claims 39 - 43.**

31 The Examiner states, incorrectly:

32 "Applicant argues the Examiner incorrectly asserts that Applicant has not claimed that  
33 the claimed invention is compressed by the soft tissues of the user's mouth. However,

1 Applicant merely claims the invention is adapted to compress as the user's jaw closes  
2 and expand as the user's jaw expands." Final Office Action mailed May 13, 2008, p. 2.  
3 Applicant's actual limitation in claims 39 - 43 is:

4 "A spring element

5 .....

6 having a dynamic span such that

7 .....

8 said spring element flexibly compresses to allow a user's jaws and lips to fully  
9 close ***while said spring element is within one or more of a user's cheek***  
10 ***pouches, ...***" (bold, italic emphasis added).

11 This is a functional limitation on the compressibility of the claimed structure of the anchor that  
12 distinguishes the claimed anchor from Leal's device. Leal repeatedly states, prevents a  
13 patient's mouth from closing and maintains the mouth open. Leal's statements necessarily  
14 require that Leal's device inherently resists compression by the tissues of a patient's mouth.

15 The "soft tissue" topic arose when the Examiner asserted in the Office Action of July  
16 19, 2007, pp. 2 - 3, that Leal's device

17 "can be compresses by the mouth if the jaw applies force even though the intended  
18 use is to hold the mouth open. If two fingers can compress the device, the much  
19 stronger jaw can compress it."

20 Applicant pointed out that the Examiner had factually misstated Leal. Applicant showed with  
21 detailed references to Leal's specification and claims that Leal's u-shaped upper and lower  
22 sections 12 and 14 are intended by Leal to bear upon the soft tissues of a patient's cheek  
23 pouches, and not upon the biting surfaces of a patient's teeth. Applicant argued, with  
24 detailed references to Leal, that Leal's device plainly exploits the tenderness and sensitivity  
25 of soft tissues to prevent a user's mouth from closing. Request for Further Examination,  
26 September 12, 2007, pp. 3 - 6. These detailed references appear in Appendix 1 below.

27 Applicant then filed claims 41 - 43 to the cheek pouch anchor to focus the semantic  
28 issues. They claim, among other things, that "said spring element flexibly compresses to  
29 allow a user's jaws and lips to fully close ***while said spring element is within one or more***  
30 ***of a user's cheek pouches...***"

31 Applicant explicitly defines a "user's cheek pouch" to be framed by the soft tissues of a  
32 user's mouth and the cheek-adjacent side of a user's teeth. Specification, paragraph [0041]  
33 and Figure 3, element 50, as described in Specification paragraph [0176]. The biting

1 ("occlusal") surfaces of the user's teeth are beyond the defined limits of the cheek pouch.

2 Therefore, Applicant's claim phrase "compresses to allow a user's jaws and lips to fully  
3 close while said spring element is within one or more of a user's cheek pouches" necessarily  
4 involves compression by the soft tissues of the user's cheek pouch but does not involve  
5 compression by the biting surfaces of a user's teeth or by the occlusal surfaces of a user's  
6 lips.

7  
8 The Claimed Compressibility Of Applicant's Cheek Pouch Anchor While Within A  
9 Cheek Pouch Structurally Differs From Leal's Device.

10 The correct comparative test of the structural ease of compressibility of Applicant's  
11 anchor versus Leal's device is compressibility by the power of soft tissues of a user's cheek  
12 pouches. Compressibility by the power of the biting surfaces of a user's teeth is non-  
13 comparable. The critical structural difference in compressibility is that Applicant's anchor  
14 does "flexibly compress ... while said spring element in within one or more of a user's cheek  
15 pouches." By structural distinction, Leal's device prevents the patient's mouth from closing  
16 when Leal's device is inserted into the user's two cheek pouches. Assuming without  
17 conceding the Examiner's hypothesis that Leal's device could be compressed by use of the  
18 biting surfaces of a user's teeth on Leal's tabs (32, 24), the Examiner's hypothesized  
19 compressibility of Leal's device by the greater power of the biting surfaces of a user's teeth  
20 would be a structural difference, not a structural equivalence.

21  
22 The Examiner Contradicts Leal's Specification and Claims When Rejecting Applicant's  
23 Claim Limitations "compress as a user's jaws close" and "flexibly compresses to allow  
24 a user's jaws and lips to fully close while said spring element is within one or more of a  
25 user's cheek pouches."

26 Leal's specification and claims state many times that his retractor "prevents" a patient's  
27 mouth from closing and maintains a patient's mouth open to enable a dentist to perform  
28 dental operations. Leal never states that his retractor can be compressed by the biting  
29 surfaces of a patient's teeth, nor, indeed, by any other tissues of a patient's mouth.  
30 (extensive, detailed citations to Leal in Appendix 1 below).

31 Applicant specifically traverses the Examiner's speculations that Leal's tabs (32, 34)  
32 could be compressed by a patient's lips or by a patient's teeth. The Examiner's speculations  
33 are factually unsupported. *MPEP § 2144.03, subd. C*. They are inconsistent with Leal's

1 stated purpose. Leal's tabs (32, 34) are there to provide mechanical advantage enabling  
2 compression of Leal's device by the dentist's fingers, not by the patient's teeth or lips.

3 The Examiner's speculative hypothesis that Leal's tabs (32, 34) could be compressed  
4 by a patient's lips not only is contrary to Leal's stated purpose, but also is contrary to the  
5 common knowledge that fingers have much greater compressive power than do lips.

6 Before a patient could bring the biting surfaces of a patient's teeth to bear on Leal's  
7 tabs (32, 34) Leal's device would have to be contorted into a shape or position incompatible  
8 with Leal's stated purpose. Leal's u-shaped structure, formed of upper and lower sections  
9 (12, 14), leg sections (20, 22), and flexible connections (24), is designed to fit between lips  
10 and gums, outside a patient's dental arches, where the biting surfaces of a patient's teeth  
11 could not bear on Leal's sections (12, 14) to compress the flexible connections (24). Leal's  
12 sections (12, 14) bear on the soft tissues of a patient's cheek pouches, which is why Leal  
13 cushions them with cotton rolls. (col. 5, l. 3 - 30). When positioned in a patient's mouth,  
14 Leal's tabs (32, 34) project "forwardly", that is, between the patient's lips, so as to be grasped  
15 by the dentist's fingers for compression of Leal's upper and lower sections (12, 14) and  
16 flexible connections (24).

17 The Examiner's contorted constructions of Leal, in an attempt to achieve compression  
18 by the patient's teeth, do not show anticipation of the claimed cheek pouch anchor.

19 Purely by argument, the Examiner incorrectly imputes to Leal's device compressibility  
20 by a patient's teeth. Leal's device would be malfunctioning if its resistance to compression  
21 were so weak that a patient could compress the Leal device while it is in the patient's mouth.

22 The Examiner argues that some hypothetical patient might forge through pain and  
23 injury to compress Leal's device while the device was inserted into the patient's mouth,  
24 despite Leal's many statements that Leal's device prevents the patient's mouth from closing  
25 and maintains the mouth open. Final Office Action, mailed May 13, 2008, p. 3. This is a  
26 purely speculative argument by the Examiner that lacks any supporting citation to other prior  
27 art or other evidence. See *MPEP* § 2144.03, *subd. A* (to take official notice of facts  
28 asserted to be well-known or common knowledge in the art, such facts must be capable of  
29 instant and unquestionable demonstration). The Examiner's personal speculation is not prior  
30 art. It does not establish either anticipation or obviousness.

31  
32 The Examiner's Arguments Exceed the Limits of The Inherent Feature Doctrine.

33 The Examiner tacitly but incorrectly applies the inherent feature doctrine, by imputing to

1 the Leal device characteristics that are not disclosed by Leal and that would impair or defeat  
2 the stated purpose of Leal.

3 To invoke the inherent feature doctrine an examiner must provide evidence that  
4 descriptive matter missing from a reference is **necessarily** present in the thing described in  
5 the reference; that it may occur or be present under some circumstances is insufficient. See  
6 *MPEP 2112, subd. IV*. Where a characteristic must be achieved by optimization of a prior art  
7 device, that characteristic is not necessarily present in the prior art and therefore is not  
8 inherent. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955; *In re Oelrich*, 666 F.2d 578,  
9 581-582, 212 USPQ 323, 326 (CCPA 1981). See also, *Ex Parte Levy*, 17 USPQ2d 1461,  
10 1664.

11  
12 The Examiner Confuses The Test for an Inherent Feature For Purposes of Anticipation  
13 With the Distinctly Different Test for Obviousness.

14 If a proposed modification would render a prior art device unsatisfactory for its intended  
15 purpose, then even when evaluating obviousness there is no suggestion or motivation to  
16 make the proposed modification. See *MPEP § 2143.01, subd. V*. It necessarily follows that  
17 a characteristic that would appear only in a malfunctioning device not only is non-obvious, but  
18 also is not inherent in that device.

19 Even if the Examiner's hypotheses could be proven true (which the Examiner has not  
20 done), they would only show that Leal's device was unsatisfactory for Leal's intended  
21 purpose of preventing a dental patient's mouth from closing during the performance of dental  
22 procedures. The Examiner's unproven hypotheses cannot show that Leal's device inherently  
23 is compressible by soft tissues of a patient's cheek pouches, contrary to Leal's stated intent,  
24 so as to render Leal's device anticipatory of Applicant's claimed cheek pouch anchor.

25 For purposes of an obviousness analysis, Leal teaches away from Appellant's device  
26 because Appellant's solution (a resilient filament that remains stable within in a cheek pouch  
27 by expanding and compressing while the user's jaws open and close without any manual  
28 intervention by a dentist). Applicant's solution would render Leal's device inoperative for  
29 Leal's stated purpose. Compare *McGinley v. Franklin Sports*, 262 F.3d 1339, 1354, 60  
30 *USPQ2d 1001 (Fed. Cir. 2001)* (if references taken in combination would produce "a  
31 seemingly inoperative device," then such references teach away from the combination and  
32 thus cannot serve as predicates for a prima facie case of obviousness.)  
33

Even If Leal's Device Could Perform Operations of The Claimed Cheek Pouch Anchor, Leal Still Would Not Anticipate the Claims Because There Are Structural Differences.

Even if a prior art device performs all of the functions recited in an apparatus claim, the prior art cannot anticipate the claim if there is any structural difference. *MPEP* § 2114.

Therefore, the Examiner's argument that a patient could compress Leal's device using teeth or lips on Leal's tabs (32, 34) would not show that Applicant's claims read on Leal's device, even if the Examiner's argument were factually correct (which it is not according to Leal's specification and claims as showed by the detailed citations in Appendix 1 below). Applicant's cheek pouch anchor, as claimed, does not have any structural equivalent of Leal's tabs (32, 34).

The Examiner factually misstates Leal by arguing that a dental patient could compress Leal's device by biting down with the patient's teeth upon Leal's tabs (32, 34) while Leal's device was inserted into the patient's cheek pouches. The occlusal (biting) surfaces of a patient's teeth are beyond the limits of "a user's cheek pouch" as defined in Applicant's specification paragraph [0041] and depicted as the dotted line 50 in Figure 3. Therefore, it would be irrelevant (even if it were factually correct which it is not) that a dental patient could use teeth to compress Leal's tabs (32, 34) while Leal's device was inserted into a patient's cheek pouches.

Similarly, even if it were factually correct (which it is not according to Leal's specification) that Leal's device were so easily compressible that a dental patient could compress it with the patient's lips acting upon Leal's tabs (32, 34), that still would not mean that Applicant's claims read on Leal's device. Applicant's cheek pouch anchor, as claimed, does not have any structural equivalent of Leal's tabs (32, 34) and the occlusal surfaces of a patient's lips are beyond the limits of "a user's cheek pouch" as defined in Applicant's specification paragraph [0041] and depicted as the dotted line 50 in Figure 3.

**ISSUE 3.** In claims 35 and 42, can the Examiner properly disregard Applicant's definition of the word "conduit" in Applicant's specification and substitute the Examiner's own, idiosyncratic definition so as to read Applicant's claim limitation "a conduit for a fluid" upon Leal's absorbent cotton?

**Argument on Issue 3.**

Applicant's claim limitation "a conduit for a fluid" does not read on Leal's cotton rolls.

1 Leal's cotton rolls are clamped about Leal's upper and lower sections (12, 14) by Leal's  
2 clamping elements (36, 38) and coils (40) before insertion into the patient's mouth and the  
3 cotton remains statically clamped when inside the patient's mouth. Leal, col. 4, l. 36 - col. 5,  
4 l. 30. Leal's cotton is not a "conduit" according to Applicant's explicit definition in the  
5 specification, nor according to the plain meaning of "conduit" in dictionaries. Leal states that  
6 his cotton roll acts as a cushioning and absorbent element. Leal, col. 4, l. 51 - 55. Leal's use  
7 of cotton is consistent with common understanding of the action of a cotton roll. Even if one  
8 were to hypothesize that Leal's cotton roll might act as a wick to transfer fluid from one end of  
9 the wick to the other end, still it is common knowledge that a wick and a conduit function  
10 according to different scientific principles. A wick employs molecular attraction whereas a  
11 conduit confines flow induced by gravity or a pressure differential. This is a plain structural  
12 difference. *MPEP* § 2114.

13 Applicant's specification paragraph [0224] explicitly defines the word "conduit" for use  
14 in the claims as follows:

15 [0224] "Conduit" means a hollow tube or channel capable of conveying fluids along its  
16 longitudinal axis, which axis may be curved. A conduit may have one or more separate  
17 passageways through it and thus have a plurality of longitudinal axial dimensions. The  
18 conduit's cross-section may enclosed (as in a tube by way of non-limiting example), or  
19 partially open (as in an open-top channel by way of non-limiting example). The  
20 conduit's radial cross-section may have a single-focus radius (circular cross-section) or  
21 may have multi-focal radii or variable length radii and thus have a plurality of radial  
22 dimensions (oval or other variant shape which can include multi-lateral shapes, that is,  
23 a plurality of sides). A conduit's radial cross-section may vary along the conduit's  
24 longitudinal axis."

25 Applicant's explicit definition is consistent with definitions in several, different dictionaries, as  
26 showed in the discussion below.

27 Where the application provides an explicit definition for a term, that definition will  
28 control interpretation of the term as it is used in the claim. *MPEP* § 2111.01, *subd. IV*, citing  
29 *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065,  
30 1069 (*Fed. Cir.* 1999). The Examiner explicitly violated this rule of law that an applicant is  
31 entitled to be his own lexicographer. *Innova/Pure Water, Inc. v. Safari Water Filtration*  
32 *Systems, Inc.* 381 F. 3d 1111, 1117; 72 USPQA2d (BNA) 1001 (*Fed. Cir.* 2004) *states*:

33 A patent applicant thus has the flexibility to imbue new or old terms with a different



1 meaning than they would otherwise have to a person of ordinary skill in the art. See  
2 *Autogiro Co. of Am. v. United States*, 181 Ct. Cl. 55, 384 F.2d 391, 397 (Ct. Cl. 1967)  
3 ("Patent law allows the inventor to be his own lexicographer."). All that is required is  
4 that the patent applicant set out the different meaning in the specification in a manner  
5 sufficient to give one of ordinary skill in the art notice of the change from ordinary  
6 meaning. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994); *Intellicall, Inc. v.*  
7 *Phonometrics, Inc.*, 952 F.2d 1384, 1387-88 (Fed. Cir. 1992)."

8 See MPEP § 2173.01 and MPEP § 2173.05(a).I.

9 The Examiner rejected claims 35 and 42 by substituting the Examiner's own,  
10 inconsistent, unreasonable, idiosyncratic definition as follows:

11 "The device (10) [of Leal] has a conduit col. 4, lines 56-63) for fluid. Examiner has  
12 given the term conduit its broadest, most reasonable definition, which is an element  
13 with a hole therethrough that can transfer air of fluid, which is the cotton surround the  
14 spring element (40)." Final Office Action mailed May 13, 2008, p. 5.

15 Thus, the Examiner simply ignored the explicit definition in Applicant's specification.

16 Ordinarily, an examiner must give words of the claim their broadest reasonable  
17 interpretation in light of the specification. This means that words must be given their plain  
18 meaning unless the plain meaning is inconsistent with the specification *MPEP § 2111.01,*  
19 *subd. I.* The Examiner's idiosyncratic definition of "conduit" is inconsistent with Applicant's  
20 specification. It also is excessively broad and unreasonable when tested by the plain-  
21 meaning standard. The Examiner eliminates the semantic distinction between "hole" and  
22 "conduit."

23 Applicant's claim limitation "conduit for a fluid" does not read on Leal's cotton rolls.

24  
25 Applicant's Definition of "Conduit" is Consistent With Dictionary Definitions; The  
26 Examiner's Definition Is Not.

27 Applicant's explicit definition in Specification, para. [0224], is consistent with the  
28 ordinary and customary meaning stated in dictionaries that define "conduit" as follows:

29 "1. a channel for conveying water or other fluid. 2. a tube or trough protecting electric  
30 wiring. ORIGIN ME: from OFr., from med. L. conductus, from L. conducere (see conduct)."  
31 *Oxford University Press (electronic version supplied with the WordPerfect word processing*  
32 *program, ver. 13, Corel Corporation, 2005).*

33 "n. [ME. & OFr < L. conductus. pp. of conducere; see CONDUCE]. 1. a pipe or

1 channel for conveying fluids. 2. a tube or protected trough for electric wires. 3 [Archaic], a  
2 fountain." *Webster's New World Dictionary of the American Language, College Edition,*  
3 *1959, The World Publishing Company, Cleveland and New York.*

4 "1. a channel for conveying fluids. 2. a structure containing ducts for electrical  
5 conductors or cables." *Random House Webster's Dictionary, 1993, Random House, Inc.,*  
6 *New York.*

7 "n. a channel or pipe conveying water or other fluid or covering electric wires, etc.: a  
8 fountain for supplying the public with water. [Fr. conduit - L. conductus - conducere, to lead.]  
9 *Chambers's Twentieth Century Dictionary, 1965, Hawthorne Books, Inc., New York.*

10 The Examiner's definition, an element with a hole therethrough, is excessively broad  
11 and not consistent with these dictionary definitions. The Office Action does not cite any  
12 authoritative source for the Examiner's definition. It is idiosyncratic, unreasonably vague, and  
13 indefinite.

14 The Examiner has failed to discharge the Examiner's burden to show that the  
15 Examiner's definition of "conduit" is the meaning that a person of ordinary skill in the art in  
16 question would have given the word "conduit" at the time the application was filed. *MPEP §*  
17 *2111.01, subd. III.*

18  
19 **ISSUE 4.** In claims 33 - 38, has the Examiner incorrectly refused to consider Applicant's  
20 claim phrase "adapted to ...." and any limiting language following that phrase?

21  
22 **Argument on Issue 4.** The Examiner states:

23 "The "adapted to ..." language has not been considered since it has been held that the  
24 recitation that an element is "adapted to" perform a function is not a positive limitation,  
25 but only requires the ability to so perform. It does not constitute a limitation in any  
26 patentable sense. *In re Hutchinson, 69 USPQ 138.*" Final Office Action mailed May  
27 13, 2008, pp. 4-5, and p. 6.

28 The Examiner materially misstates the current state of the law in general and misstates *In re*  
29 *Hutchinson* in particular. There is no such legal principle.

30 In MPEP § 2173.05(g) the USPTO has adopted the modern view that the "adapted to  
31 ..." phrase can be employed to state a valid functional limitation, citing *In re Venezia, 530 F.*  
32 *2d 956, 189 USPQ 149 (CCPA 1976).*

33 In *In re Hutchinson*, the phrase "adapted for" appeared in the "introductory clause" (that

1 is, in the preamble before the word "comprising") of claims 42 and 43 that were at issue  
2 there. *In re Hutchinson*, 33 C.C.P.A. 879 at 882-883. Thus, *In re Hutchinson* never has  
3 stood for the Examiner's proposition that the phrase "adapted for" has no patentable weight  
4 where it is recited in the body of the claim after the word "comprising".

5 The MPEP does not cite or adopt *In re Hutchinson* for the proposition stated by the  
6 Examiner in the instant Office Action. The *In re Hutchinson* discussion of the "adapted for..."  
7 phrase was written in 1946. The Patent Act of 1952 then was enacted. Twice thereafter the  
8 Court of Customs and Patent Appeals affirmed use of the phrase "adapted to ....". *In re Land*  
9 *and Rogers*, 386 F.2d 866, 872, 882, 885, 54 C.C.P.A. 806, 151 U.S.P.Q. 621 (CCPA 1966);  
10 *In re Venezia*, supra 530 F.2d 956 at 959 (CCPA 1976), and this case law is followed and  
11 cited in the most recent edition of the MPEP.

12 The Examiner's refusal to consider "adapted to ..." and any following language is plain  
13 error of law.  
14

15 **ISSUE 5.** Does Leal's device anticipate the particular kind of structural adjustability of the  
16 cheek pouch anchor that is stated in claims 36 and 39?  
17

18 Argument Concerning Issue 5.

19 Applicant claims a cheek pouch anchor (with all the key limitations of such an anchor)  
20 having a whole spring element span size, formed by a plurality of connected loops, with each  
21 loop having a loop span size. Applicant claims that the whole spring element span size is  
22 adjustable by a particular structural mechanism of adjusting the span size of at least one of  
23 the plurality of connected loops.

24 The Examiner rejected claims 36 and 39 to an adjustable cheek pouch anchor solely  
25 on grounds of anticipation by Leal. [Note 3]

26 The Examiner's asserts two arguments for anticipation of claims 36 and 38. The  
27 Examiner's first argument plainly, factually misstates Leal's structure and its operation as

---

3 Preliminarily, Applicant notes that the rejection of claims 36 and 39  
automatically fails if Leal is not anticipatory either (A) because of the cheek pouch  
anchor's capacity to fit within one cheek pouch, or (B) because the compressibility of  
the anchor allows a user's jaws and lips to fully close while the anchor is in a user's  
cheek pouch.

1 follows:

2 "The [Leal] device (10) is formed of metal (col. 1, lines 52 - 55) and configured into a  
3 plurality of loops (fig. 1), wherein if one loop has its span increased or decreased it will  
4 result in another loop increasing or decreasing span because the device is made of  
5 continuous pieces of wire. The plurality of loops is combined for form a spring element  
6 (40) with an element span size (fig. 1)." Final Office Action mailed May 13, 2008, p. 5.

7 The Examiner's theory of adjustment of Leal's whole span size by adjustment of coils (40) is  
8 unworkable. Leal's coils (40) do not control the whole span of Leal's device (10). The  
9 whole span of Leal's device (10) is created by displacement of Leal's u-shaped upper and  
10 lower sections (12, 14) and leg portions (20, 24) relative to each other, operating Leal's  
11 resilient connections (24) about axis of symmetry A-A (fig. 1). Leal, col. 3, l. 50 - 56. Leal's  
12 coils (40) are affixed to Leal's leg portions (20, 22) at points forward of resilient connections  
13 (24). Therefore, coils (40) control displacement of clamping element (16) from upper section  
14 (12) or control displacement of clamping element (38) from lower section (14). Leal's coils  
15 (40) are attached to Leal's clamping elements (36, 38) to statically clamp the cotton rolls that  
16 encompass, and cushion, Leal's upper and lower sections (12, 14). Leal, figs. 1, 2; col. 4, l.  
17 36 - col. 5, l. 12. Adjustment of the loop size of Leal's coils (40) would not materially affect  
18 the expansion or compression of the whole span of Leal's device (10). (Leal, fig. 1). The  
19 only exception Applicant can conceive would be where the loop size of Leal's coils (40) was  
20 so unreasonably large that coils (40) would prevent displacement of upper and lower sections  
21 (12, 14) towards each other during compression about flexible connections (24), thus  
22 defeating Leal's stated purpose.

23 The Examiner compounds his factually erroneous construction of Leal by confusing  
24 anticipation with obviousness:

25 "In order to form dental devices that conform to the contours of different user's mouths  
26 one would have to bend the device into a specific size and shape to fit the user.

27 Therefore, it would be obvious to one of ordinary skill in the art to bend the wires of the  
28 Leal device in order to better fit the user." Final Office Action mailed May 13, 2008, p.  
29 3.

30 That is, the rejection is on the formal ground of anticipation but the Examiner's supporting  
31 argument is obviousness. The difference between arguments for anticipation and  
32 obviousness is quite important to proper analysis.

33 The Examiner leaps from his questionable premise (that it would be obvious for one of

1 ordinary skill to adjust Leal's device by ductilely bending it) to an incorrect, unfounded  
2 conclusion that it would be obvious to bend Leal's resilient wire *according to the particular*  
3 *structural mechanism that Applicant claims* for achieving adjustability in the cheek pouch  
4 anchor.

5 The Examiner's obviousness argument does not meet the strict test of inherency for  
6 the purpose of anticipation. See *MPEP* § 2112, *subd. IV*. Where a characteristic must be  
7 achieved by optimization of a prior art device, that characteristic is not necessarily present in  
8 the prior art and therefore is not inherent. *In re Rijckaert, supra* 9 F.3d at, 1534, 28 USPQ2d  
9 1955; *In re Oelrich, supra*, 666 F.2d at 581-582, 212 USPQ 323, 326. The Examiner fails to  
10 make out inherency for purposes of anticipation.

11 The Examiner states:

12 "Applicant does not argue the Leal device can have the wires bent to form different  
13 sizes and shapes. However, Applicant does argue the adjustments could be  
14 cumbersome, maybe not the best way to adjust the device, and maybe not necessarily  
15 the best way to adjust the device for different shaped mouths. Even though a process  
16 may not be the easiest and most effective way to accomplish a goal does not mean  
17 ***that it is not capable of it.*** As Applicant admits, the Leal device ***is capable of having***  
18 ***the wires bent to adjust the span size*** and therefore the lease device reads on  
19 Applicant's claims ***because it is capable of having the wires bent that would result***  
20 ***in an increase or decrease in the loop span size.***" Final Office Action, May 13,  
21 2008, p. 4. (bold, italic emphasis added). [Note 4]

---

4 Applicant does not admit, but rather specifically traverses, the Examiner's  
hypothesis that one of ordinary skill would "bend the wires of the Leal device in order  
to better fit the user." Elsewhere the Examiner also states, "The Leal device is  
intended to be a resilient device in order to hold the user's mouth in an open position  
and therefore would remain resilient with the other elements are attached to the device  
that assist in the dental procedure." Final Office Action mailed May 13, 2008, p. 3.  
Evidently the Examiner is unmindful that his two hypotheses inherently conflict. A  
wire's ductility is exploited when bending the wire to impose a semi-permanent new  
shape that remains after external force ceases. A wire's resilience is exploited to  
restore the wire to its original shape after external force ceases. That is, ductility and  
resilience tend to have mutually exclusive ranges of motion. The properties of Leal's

(continued...)

1 The Examiner here again confuses the test of inherency for purposes of anticipation with the  
2 test for obviousness -- and as a result misapplies both tests. The test for inherency is that a  
3 feature **necessarily** is present without having to optimize the prior art device.

4 The very different test for obviousness includes a determination whether one of  
5 ordinary skill in the art would perceive a suggestion in Leal, or would have a motivation, to  
6 modify the Leal device *according to the particular structural mechanism claimed by Applicant*.

7 Throughout, the Examiner uses the improper test of "capable" (in the sense of potentially  
8 possible) rather than the proper test of inherency, "necessarily present."

9 The Examiner does not make out a prima facie case for obviousness of Applicant's  
10 adjustment mechanism by merely stating that it would be within the capability of one of  
11 ordinary skill in the art to modify Leal by bending its wires to fit a particular patient's mouth.  
12 Prima facie obviousness does not arise from mere capability to act without some objective  
13 motivation for one of ordinary skill to so act. *MPEP § 2143.01, subd. IV*. Mere conclusory  
14 statements by the Examiner do not establish prima facie obviousness. *KSR International Co.*  
15 *v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed. 2d 705, 82 USPQ2d(BNA) 1385 (U.S. Sup.  
16 Ct., 2007). Mere capability of one of ordinary skill is not sufficient to establish prima facie  
17 obviousness. *MPEP § 2143.01, subd. IV*. The Examiner has not showed that one of  
18 ordinary skill in the art would have a reasonable expectation of successfully using Applicant's  
19 complex mechanism of adjustment, rather than using the simple, obvious method of bending  
20 Leal's flexible connections (24) -- even if one assumes that Leal's wire had been optimized  
21 with the necessary balance of ductility and resilience. *MPEP § 2143.02*.

22 As the Examiner noted (and apparently conceded), Applicant pointed out in detail why  
23 one of ordinary skill in the art would adjust the span size of Leal's whole spring element by  
24 the most straightforward, simple, obvious, predictable method which is to bend Leal's flexible

---

4(...continued)  
wire would have to be optimized to simultaneously enable both the resilience that Leal  
specifies and the susceptibility to ductile bending that the Examiner hypothesizes.  
While it arguably **might** be possible that Leal's wire **could** simultaneously possess the  
ductility to be reshaped by bending to fit patient deformities and also still possess the  
resilience that is essential to Leal's intended purpose, it is not **necessarily** true that  
Leal's wire would possess that balance of resilience and ductility. Thus, the  
Examiner's bending hypothesis fails the test for an inherent feature, and does not  
show that Leal is anticipating prior art.

connections 24 about Leal's axis of symmetry (A-A in Leal figure 1). This simple method would be used rather than using the more complicated mechanism of Applicant's claims 36 and 39.

As Applicant pointed out, such alteration of whole spring element span size by mutually converse alteration of Leal's u-shaped upper and lower sections (12, 14) not only would be more complex and unpredictable than simply bending connections 24, but also it obviously would have numerous undesirable side effects. Such adverse effects include:

- shifting the axis of flexion of Leal's connections 24 away from Leal's axis of symmetry A-A (fig. 1), thus inducing asymmetry into Leal's u-shaped upper and lower sections (12, 14) and altering the fit of the device to the patient's dental arches;

- shifting the location of Leal's tongue depressor (26, 28, 30) relative to the axis of symmetry A-A and thus relative to a patient's tongue and teeth;

- shifting the tabs (32, 34) into asymmetry relative to each other, thus impairing compression of them with fingers;

- shifting the points of attachment to upper and lower sections (12, 14) by coils (40) and cotton clamps (36, 38) relative to the axis of flexion (A-A) and flexible connections (24), and

- potentially impairing the resilience that is essential to maintain the patient's mouth open.

Applicant's over arching point is that these obvious complications and risks of adverse side effects would strongly motivate one of ordinary skill to avoid adjusting Leal's device by converse changes in the loop sizes of Leal's u-shaped upper and lower sections (12, 14).

The Examiner evidently does not dispute that adverse effects would accrue nor dispute that they would be anticipated by one of ordinary skill.

The Examiner's response is:

"Even though a process may not be the easiest and most effective way to accomplish a goal does not mean ***that it is not capable of it.***" Final Office Action, May 13, 2008, p. 4.

Applicant traverses this assertion. That a process "may not be the easiest and most effective way to accomplish a goal" shows its ***non***-obviousness.

The structural mechanism of adjustment stated in claims 36 and 39 is not inherent in Leal for purposes of anticipation. It is not an obvious mechanism for adjusting Leal.

**ISSUE 6.** When each of Applicant's claims 33 - 36 and 39 - 42 is viewed as a whole, does

1 Leal anticipate that claim?

2  
3 Argument Concerning Issue 6.

4 Claims must be construed as a whole, giving weight to each and all limitations. When  
5 this is done, Applicant's claims are not anticipated by Leal. The Examiner has contorted  
6 Leal on an element by element basis, but when one attempts to view the Examiner's various  
7 contortions of Leal as a whole, the Examiner's hypotheses are unworkable. Viewed as  
8 whole, Applicant's claims do not read on Leal.

9 The tests for equivalence of prior art to a means-plus-function claim for purposes of 35  
10 U.S.C. § 112 are closely analogous to the tests for anticipation of an apparatus claim. The  
11 Examiner has not made out a prima facie case of equivalence between Leal's device and  
12 Applicant's cheek pouch anchor as claimed. *MPEP* § 2183. To be equivalent a prior art  
13 element must perform the identical function specified in the claim in the same way, and  
14 produce substantially the same result as the corresponding element disclosed in the  
15 specification. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 54 USPQ2d 1308  
16 (Fed. Cir. 2000). Unless an element in prior art performs the identical function specified in  
17 Applicant's claim, that prior art cannot be an equivalent for the purposes of 35 U.S.C. § 112,  
18 sixth paragraph. *MPEP* § 2184, subd. II, citing *Pennwalt Corp. v. Durand-Wayland, Inc.* 833  
19 F.2d 931, 4 USPQ2d 1737 (Fed. Cir. 1987), cert. denied, 484 U.S. 961 (1988).

20  
21 The Simplicity of The Solution to A Problem Does Not Defeat Patentability.

22 When the art in question is relatively simple, as Appellant's solution is here, the  
23 opportunity to judge by hindsight is particularly tempting (see *McGinley v. Franklin Sports*,  
24 *supra*, 262 F.3d at 1351), so particular awareness of that risk is important here. It still is the  
25 law under the U.S. Supreme Court's recent decision that an examiner must guard against  
26 slipping into the use of hindsight and must guard against the temptation to read into prior art  
27 the teachings of the invention in issue. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct.  
28 1727, 1742, 167 L.Ed. 2d 705, 82 USPQ2d(BNA) 1385 (U.S. Sup. Ct., 2007).

29 Complexity is not a requirement for patentability. *Panduit Corporation v. Dennison*  
30 *Manufacturing Co.*, 810 F. 2d 1561, 1572; 1 USPQ 2d (BNA) 1593 (Fed. Cir. 1987). It is  
31 incorrect to hold that an invention was obvious when made, simply because the invention is  
32 simple in nature and is easily understood when described in a patent specification.  
33 Experience has shown that some of the simplest advances have been the most nonobvious.



1 *Van Veen v. United States*, 181 Ct. Cl. 884, 891, 156 USPQ (BNA) 403 (1967).

2 The Examiner has not offered any evidence showing why one of ordinary skill in the art  
3 would modify Leal's device to render it inoperative for Leal's stated purposes, absent  
4 application by hindsight of the teaching of Appellant's invention to achieve Appellant's very  
5 different objectives.

6  
7 ARGUMENT RE REJECTIONS UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS.  
8

9 ISSUE 7. Are Claims 37, 38 and 43, to a cheek pouch anchor combined with a capacity to  
10 carry and release a substance in a user's mouth, rendered obvious by Leal (U.S. Patent  
11 5,199,872) in view of Diaz (U.S. Patent 4,041,937)?  
12

13 Argument Concerning Issue 7.

14 Claims 37, 38 and 43 combine the cheek pouch anchor with a capacity to carry a  
15 substance and release that substance in the user's mouth.

16 The Examiner's rationale is that Leal anticipates all of the elements of Applicant's  
17 cheek pouch anchor in claims 37, 38 and 43, except for the added element comprising a  
18 capacity to carry and release a substance. The Examiner cites Diaz (U.S. Patent 4,041,937)  
19 only to demonstrate that additional capacity in prior art. The Examiner does not cite Diaz to  
20 cure any failure of Leal to anticipate the claimed elements of the cheek pouch anchor.

21 Applicant traverses, for all the reasons stated with respect to Issues 1 - 4 above, the  
22 Examiner's conclusion that Leal anticipates the claimed cheek pouch anchor. If Leal does  
23 not anticipate the cheek pouch anchor, then the combination of Leal with Diaz does not  
24 render claims 37, 38 and 43 obvious.

25 Applicant does not raise any issue concerning the limited purpose for which the  
26 Examiner cites Diaz. Applicant acknowledges that it was well known in the prior art to soak  
27 a wad of cotton with a substance and attach the soaked cotton to an appliance to release that  
28 substance in a user's mouth. Diaz (U.S. Patent 4,041,937) is a suitable example of that  
29 technique.

30 Applicant's claims are not obvious by reason of Leal in view of Diaz because the  
31 Examiner has incorrectly determined that Leal is equivalent to Applicant's claimed cheek  
32 pouch anchor.  
33



APPENDIX 1

Detailed Citations to Leal Showing the Examiner's Factually Incorrect Statements of the Structure and Function of the Leal Device.

Viewing Leal's FIG. 1, the leg portions (20, 22) of u-shaped upper and lower sections (12, 14) combined with the two resilient connections (24) of the Leal device are designed to fit simultaneously into both of a patient's cheek pouches. Leal's forwardly projecting tabs (32, 34) attach to front portions (16, 18) of Leal's device (10) evidently must project out between the patient's open lips to enable compression and release of the device by a dentist's fingers. Leal FIG. 2.

Leal states that the features of his device "provide for isolation of the operative area of the patient's mouth and ***prevents the patient from closing his mouth*** during the performance of dental work." Leal, col. 1, lines 35 - 38. Leal repeatedly states that the function of his device is to maintain a patient's mouth in an open position. Leal, col. 1, lines 6-9, lines 45 - 49, lines 60 - 61; col. 2, lines 58 - 62; col. 3, lines 8 - 13, col. 5, lines 26 - 30 ("It will be appreciated that by releasing tabs 32 and 34, the wire exerts pressure on the upper and lower jaws of the patient to maintain the mouth in an open position, while simultaneously isolating the area for dental work.") See also Leal claim 1, col. 6, at lines 29 - 34 ("... such that, upon placement of the appliance in the patient's mouth, the appliance maintains the patient's mouth in an open position, ..."); claim 10, preamble, col. 7, lines 24 - 26 and lines 44 - 50; claim 11, preamble, col. 7, lines 58 - 60 and col. 8, lines 9 - 15; claim 12, preamble, col. 8, lines 28 - 30, and lines 48 - 53.

The Examiner incorrectly states,

"Moreover, the device [of Leal] would be able to be compressed by the user's jaw and teeth if it can be compresses by two finger that are weaker than the jaw of a person, wherein the teeth would fit into the spot where the two fingers compress the device."

Office Action, Nov. 9, 2007, pp. 2 -3.

Applicant specifically traverses the Examiner's factual assertion that a user's "teeth would fit into the spot where the two fingers compress the [Leal] device." The Examiner literally is contradicting Leal's specification.

The Examiner cannot show how the Examiner's proposed mode of operation of Leal's device (compression of tabs 32 and 34 by the user's teeth and jaws) is even physically possible when Leal's device is inserted in the patient's mouth. This is because a patient's

1 teeth and jaws do not bear upon Leal's tabs (32, 34) when Leal's device is inserted between  
2 a user's gums and lips as Leal's specification describes.

3 Leal's specification describes his device as follows:

4 "...a frame including upper and lower generally U-shaped sections spaced in relation  
5 one to the other and generally conformal in shape to the spaces between the upper  
6 gum and lip and lower gum and lip, respectively, of the mouth of a human patient, ..."  
7 Leal, 2:62-66. "Secured to the front portions 16 and 18 of upper and lower sections  
8 12 and 14, respectively, are a pair of **forwardly projecting** tabs 32 and 34..... The  
9 tabs 32 and 34 are U-shaped in configuration and generally bowed to accommodate  
10 the dentist's fingers, so that the tabs may be used to displace the upper and lower  
11 sections 12 and 14, respectively, toward and away from one another to facilitate  
12 insertion and removal of the appliance relative to the patient's mouth." Leal, 4:25-35.

13 Thus, Leal's U-shaped upper and lower sections (12, 14) are shaped to fit between the  
14 patient's gums and lips around the **outside** of the patient's dental arches, and therefore  
15 **outside the patient's teeth**. Leal's tabs (32, 34) project **forwardly** from U-shaped sections  
16 12 and 14 and thus necessarily must lie forward of the patient's front teeth. Leal's tabs (32,  
17 34) evidently are designed to project between the patient's lips to the outside of the patient's  
18 mouth, where the dentist can place his fingers to compress the U-shaped sections 12 and 14  
19 for insertion into and removal from the patient's mouth. See Leal's Figs. 1, 2, 4 and 5. Leal  
20 states:

21 "Once inserted, the pressure on tabs 32 and 34 may be slowly released to locate the  
22 upper and lower sections, respectively, between the patient's upper gum and lips on  
23 the one hand and the lower gum and lip on the other hand." Leal, 5:19-23.

24 Therefore, when the Leal device is positioned in the patient's mouth as described by Leal's  
25 specification, a patient cannot bring the biting surfaces of a patient's teeth to bear on Leal's  
26 tabs 32 to 34 and the patient cannot use the biting surfaces of patient's teeth to compress  
27 Leal's tabs (32, 34).

28 The Examiner responded with his final assertion on May 13, 2008, as follows:

29 "Applicant argues that Leal's tabs (32, 34) would not contact the teeth of the user;  
30 however, the intended use is for the user's teeth not to contact the tabs; but it would be  
31 obvious that one's teeth could be able to contact the tab, depending upon the size and  
32 placement of the device. Moreover, Leal's device could be compressed by the lips of  
33 the user or by compression of the jaw when the user's closed his/her mouth." Office

1 Action mailed May 13, 2008, p. 2, second paragraph.

2 That is not obvious. Rather, the Examiner's most recent assertion directly contradicts Leal's  
3 explicit statement that Leal's device **"prevents the patient from closing his mouth** during  
4 the performance of dental work." Leal, col. 1, lines 35 - 38. Nothing in Leal's specification  
5 states or even suggests that a patient could compress Leal's device with any part of the  
6 patient's mouth, much less with a patient's lips. To the contrary, when Leal's device is  
7 functioning to "prevent the patient from closing his mouth," according to Leal's stated  
8 intention, the patient could not compress Leal's device with the patient's lips. A weakness in  
9 the Leal device, that enabled a patient to compress the device and close the patient's mouth,  
10 would be a malfunction that defeated Leal's repeatedly stated purpose to "maintain the mouth  
11 open" for dental procedures.

12 Contrary to the Examiner's unexplained assertion, it is not "obvious that one's teeth  
13 could be able to contact the tab, **depending upon the size and placement of the device.**"  
14 (emphasis added). The Examiner's cryptic phrase "depending upon the size and placement  
15 of the device" is an evasion of the Examiner's fundamental duty to provide a reasoned  
16 explanation for the Examiner's decision. The Examiner has substituted the word "obvious"  
17 for a reasoned mechanical analysis founded in explicitly cited prior art.

18 "Since patent examiners cannot normally be compelled to testify in legal proceedings  
19 regarding their mental processes (see MPEP § 1701.01), it is important that the written  
20 record clearly explain the rationale for decisions made during prosecution of the  
21 application." MPEP § 706.02(j).

22 Appellant has attempted, with little success, to imagine and guess what the Examiner may  
23 think is "obvious."

24 If one were to shrink the Leal device in size so that the device could be placed within a  
25 patient's mouth and positioned where the patient's teeth could compress Leal's tabs 23 and  
26 34, then that shrunken Leal device would have to be placed **inside the patient's dental**  
27 **arches** where that shrunken Leal device would obstruct the dentist's operating field. That  
28 would defeat Leal's repeatedly stated purpose to maintain the mouth in an open position to  
29 expose the operating areas within the mouth. Leal, col. 1 lines 6 - 15, col. 3, lines 18 - 21. If  
30 a dentist placed such a shrunken configuration of Leal where tabs (32, 34) could be  
31 compressed by a patient's teeth, then Leal's device could not function equivalently to  
32 Applicant's cheek pouch anchor because Leal's device then would not be in a cheek pouch,  
33 but rather Leal's device would lie between the biting ("occlusal") surfaces of the patient's

1 teeth that Appellant's anchor is designed to avoid. Appellant's anchor is designed to function  
2 within a cheek pouch that by definition is ***outside the user's dental arches***.

3 Applicant cannot even imagine how inflating the size of the Leal device could enable a  
4 patient to bring the patient's teeth to bear on Leal's tabs (32, 34) -- and the Examiner  
5 provides no hint how this could be so.

6 Applicant can imagine reversing the orientation of the Leal device, front to back, when  
7 placing it into a patient's mouth so that Leal's tabs (32, 34) could be inserted between the  
8 patient's teeth. That would leave most of the Leal device projecting through the patient's lips  
9 and outside of the patient's mouth. Such a reversed orientation would be unstable and would  
10 obstruct the dentist's access to the operating area. No person skilled in the art and using  
11 common sense would do such an unreasonable thing.

12 Leal's device could not function equivalently to Applicant's cheek pouch anchor in any  
13 of the shrunken, inflated, or reversed orientation configurations. Applicant cannot make  
14 sense of the Examiner's unsupported assertion. It is an unreasonable, factually erroneous  
15 construction of Leal's specification.

1  
2 (viii) CLAIMS APPENDIX.

3 Claims 1 - 32 (withdrawn from prosecution per restriction requirement).  
4

5 Claim 33: (Original) A cheek pouch anchor, for placement within a user's cheek pouch to  
6 maintain positioning of a work piece in a user's mouth while a user's jaws, inter occlusal  
7 space, and lips open and close, comprising:

8 A spring element adapted

9 - to be placed within a user's cheek pouch, and

10 - to compress as a user's jaws close, and

11 - to resiliently expand so as to form and maintain a span bridging across a user's inter  
12 occlusal space and a user's lip opening formed as a user's jaws and lips open and  
13 close, and

14 - to receive joinder to a work piece, and

15 having structural strength sufficient, when joined to a work piece, to maintain placement  
16 within a user's cheek pouch while a user's lips and jaws open and close.  
17

18 Claim 34: (Original) The cheek pouch anchor of claim 33 wherein said spring element is  
19 formed of at least one of the following:

20 metal,

21 plastic,

22 resilient monofilament plastic line.  
23

24 Claim 35: (Original) The cheek pouch anchor of claim 33 further comprising:

25 said cheek pouch anchor is joined with a conduit for a fluid, which conduit is adapted  
26 for placement at least partially in a user's cheek pouch.

1 Claim 36: (Original) The cheek pouch anchor of claim 33 wherein said spring element  
2 comprises:

3 a resilient filament

4 - which is configured into a plurality of connected loops, each loop having a loop  
5 span size, and

6 -said plurality of loops are combined to form a whole spring element with a  
7 whole spring element span size, and

8 - each one of said plurality of loop span sizes is mutually adjustable relative to at  
9 least one other of said loop span sizes, such that an increase or decrease in the loop span  
10 size of any one of said plurality of loops results in a converse decrease or increase in the  
11 loop span size of at least one other of said plurality of loops,  
12 thereby enabling adjustment of said whole spring element span size by said mutual  
13 adjustment within said plurality of loop span sizes.

14  
15 Claim 37: (Original) The cheek pouch anchor of claim 33, improved to dispense a  
16 substance within a user's mouth, wherein said spring element is adapted to receive  
17 impregnation or coating with a substance which is to be released in a user's mouth.



1 Claim 38: (Original) A cheek pouch anchor, for placement within a user's cheek pouch,  
2 comprising:

3 A spring element adapted

4 - to be placed within a user's cheek pouch, and

5 - to compress as a user's jaws close, and

6 - to resiliently expand so as to form and maintain a span

7 --- bridging across such user's inter occlusal space as such user's jaws  
8 open, and

9 --- bridging across such user's lip opening formed as such user's lips  
10 open, and

11 - to receive impregnation or coating with a substance which is to be released

12 within such user's mouth,

13 whereby said spring element is enabled to maintain its placement within a user's cheek  
14 pouch and to release such substance while such user's lips and jaws remain free to open  
15 and close.

1 Claim 39. (Added by amendment, May 17, 2007) An adjustable cheek pouch anchor, for  
2 placement within a user's cheek pouch to maintain positioning of a work piece in a user's  
3 mouth while a user's jaws, inter occlusal space, and lips open and close, comprising:  
4 a spring element formed of a resilient filament  
5 sized to fit within a user's cheek pouch, and  
6 having a dynamic span  
7 that is resiliently expandable within a user's cheek pouch to maintain a bridge  
8 across a user's inter occlusal space and lip opening that form as a user's jaws  
9 open, and  
10 that is flexibly compressible to allow a user's jaws and lips to fully close while  
11 said spring element is within a user's cheek pouch, and  
12 capable of receiving attachment of a work piece, and  
13 having structural strength that is sufficient for said spring element to maintain itself,  
14 with a work piece attached to it, within a user's cheek pouch while a user's jaws open  
15 and close; and  
16 said resilient filament  
17 is configured into a plurality of connected loops  
18 each such loop having a loop span size, and  
19 each such loop span size having a range of expansion and compression, and  
20 said plurality of connected loops form a whole spring element having a whole spring  
21 element span size, and  
22 said whole spring element span size having a range of expansion and  
23 compression, and  
24 said range of expansion and compression of least one of said loop span sizes of  
25 said plurality of connected loops is adjustable relative to at least one other of  
26 said loop span sizes, and  
27 said connected loops translate an adjustment in said range of expansion and  
28 compression of the loop span size of at least one of said plurality of connected loops  
29 into an adjustment in said range of expansion and compression of said whole spring  
30 element span size.

1 Claim 40. (Added by amendment May 17, 2007.) A cheek pouch anchor, for placement  
2 within a user's cheek pouch and releasing a substance in a user's mouth, comprising:  
3 A spring element  
4 sized to fit within a user's cheek pouch, and  
5 having a dynamic span  
6 that is resiliently expandable within a user's cheek pouch to maintain a bridge  
7 across a user's inter occlusal space and lip opening that form as a user's jaws  
8 open, and  
9 that is flexibly compressible to allow a user's jaws and lips to fully close while  
10 said spring element is within a user's cheek pouch, and  
11 having the capability to carry a substance, and  
12 having structural strength that is sufficient for said spring element, while carrying the  
13 substance, to maintain itself within a user's cheek pouch while a user's jaws open and  
14 close, and  
15 having the capability to release the some portion of the substance into the user's  
16 mouth.

1 Claim 41. (Added by amendment Sept. 12, 2007). A cheek pouch anchor, for placement  
2 within a user's cheek pouch to stabilize a work piece in a user's mouth, comprising:  
3 A spring element  
4 sized to fit within one of a user's cheek pouches, and  
5 having a dynamic span such that  
6 said spring element resiliently expands within one or more of a user's cheek  
7 pouches to maintain a bridge across a user's inter occlusal space and lip  
8 opening that form as a user's jaws open, and  
9 said spring element flexibly compresses to allow a user's jaws and lips to fully  
10 close while said spring element is within one or more of a user's cheek pouches,  
11 and  
12 having the capability to receive attachment to a work piece, and  
13 having structural strength that is sufficient for said spring element, with a work piece  
14 attached, to maintain itself within one or more of a user's cheek pouches while a user's  
15 jaws open and close.

16  
17 Claim 42. (Added by amendment Sept. 12, 2007). A cheek pouch anchor as in claim 41,  
18 further comprising:  
19 said cheek pouch anchor is joined with a conduit for a fluid, which conduit is configured  
20 to enable placement of it at least partially in one or more of a user's cheek pouches.

1 Claim 43. (Added by amendment Sept. 12, 2007) A cheek pouch anchor, for placement  
2 within a user's cheek pouch and releasing a substance in a user's mouth, comprising:  
3 A spring element  
4 sized to fit within one of a user's cheek pouches, and  
5 having a dynamic span such that  
6 said spring element resiliently expands within one or more of a user's cheek  
7 pouches to maintain a bridge across a user's inter occlusal space and lip  
8 opening that form as a user's jaws open, and  
9 said spring element flexibly compresses to allow a user's jaws and lips to fully  
10 close while said spring element is within one or more of a user's cheek pouches,  
11 and  
12 having the capability to carry a substance, and  
13 having structural strength that is sufficient for said spring element, while carrying the  
14 substance, to maintain itself within one or more of a user's cheek pouches while a  
15 user's jaws open and close, and  
16 having the capability to release a portion of the substance into the user's mouth.

1 (ix) EVIDENCE APPENDIX. There is no evidence separate from the application.

2  
3 (x) RELATED PROCEEDINGS APPENDIX. There are no related proceedings.

4  
5  
6  
7 June 19, 2008

  
Lowell R. Wedemeyer, Applicant

8 Reg. No. 32,010